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Dated: May 3, 2007

Signature:

(Robert M. Gerstein)

Docket No.: 28076/SV1094  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

**Melvin E. Wolfe, Jr. et al.**

Application No.: 10/662,683

Confirmation No.: 9788

Filed: September 15, 2003

Art Unit: 3729

For: ELECTRIC MOTOR

Examiner: T. D. Phan

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The applicants hereby request a pre-appeal brief conference for a panel of examiners to formally review the legal and factual basis of the rejections in the application, prior to the filing of an appeal brief.

No amendments are being filed with this request. This request is being submitted concurrently with the Notice of Appeal.

It is submitted that the rejections are legally and factually inadequate, for the reasons concisely described in the following pages.

**REMARKS**

Claims 11-19 stand rejected under 35 U.S.C. § 103(a) as obvious over Sunuaga et al., U.S. Patent No. 6,737,770 in view of Matsuoka et al, U.S. Patent No. 5,880,666. Applicants respectfully request reconsideration in view of the following remarks, and respectfully submit that pending claims 11-19 are not properly rejectable over the applied references for the following reasons.

Claim 11 recites a novel method of manufacturing a product, specifically an electric motor, where the claimed method to manufacture that product is faster and less expensive than prior art methods of manufacturing similar products. Claim 11 recites that the first magnet wire of the electric motor is laid across terminals on a fuse, and an end portion of the first magnet wire is connected directly to a power switch.

By connecting the magnet wire directly to the switch, a step in the manufacturing process is saved. As outlined in the Background section of the specification, a prior method of manufacturing electric motors require a first step of terminating the magnet wire at the fuse. The prior art method requires a second step where a completely separate wire is connected from the fuse to the power switch. The claimed method eliminates the second step of connecting the second, completely separate, wire to the power switch. Connecting the magnet wire to the switch, thereby eliminating the second step, provides a faster, less expensive method of manufacturing a motor.

No cited reference discloses connecting the magnet wire directly to the switch, and the office action concedes as much. Sunuaga discloses connecting an end of the magnet wire to a pin 48, and connecting the pin to a printed circuit board 40. A switching device 41 is disposed on the printed circuit board 40. Matsuoka only discloses a specific type of fuse, and fails to disclose any method of manufacturing an electric motor. Accordingly, the proposed

combination of Sunuaga and Matsuoka creates a method of manufacture where the magnet wire is not attached to the power switch, and several intermediary structures are disposed between the magnet wire and the switch.

Further, there is no suggestion for this claimed method limitation. Sunuaga has the same problems that the prior art cited in the Background has, and the claimed method overcomes these problems. Sunuaga discloses attaching extra structural materials, here a pin 48 and a printed circuit board 40 between the magnet wire and the switch. Accordingly, any method of manufacturing the device of Sunuaga requires extra manufacturing steps and time as compared to the claimed method.

The Office's reasoning for disregarding this express claim limitation is deficient. The Office argues that "there is no basic, circuit-wise difference between an 'electrically direct wire connection' and an 'electrically indirect connection through circuit track layout on PCB.'" Whether or not there is a difference "circuit-wise" is not the issue, because the focus of the claims is not on the electrical circuit. Instead, the focus is on the mechanics of the method of manufacturing a product. No cited reference discloses or suggests connecting the magnet wire to a switch as claimed.

The Office's argument seems to be that because it believes that the motor of Sunuaga and the motor that results from the claimed method of manufacture are the same "circuit-wise," every method of manufacture that results in such a motor would be obvious. In other words, it appears that the Office is arguing that simply because a prior art motor has a circuit that is similar to a second motor, all methods of manufacturing the second motor are obvious over the first motor, no matter how different the methods of construction. This is legally improper. The Office must compare the claimed method of manufacture with the methods of the prior art, not the resulting circuits.

Finally, applicants previously objected to the Office's taking of Official Notice that it would allegedly have been obvious to directly connect the magnet wire to the switch. While the Office fails to admit that it is taking Official Notice because it never actually uses those words, it relies on no documentary evidence in arguing that the noted claimed step was known in the art and simply argues that one of ordinary skill in the art would employ a method of constructing an electric motor as recited in the claims. Because applicants objected to the Official Notice in the previous response, the examiner was required to "provide documentary evidence in the next Office action if the rejection is to be maintained." MPEP § 2144.03(C). Here, the Office failed to cite any documentary evidence in the Final action that disclosed directly connecting a magnet wire to a switch. Because the Office failed to follow its own policy regarding Official Notice, the Office action is improper for this reason as well.

Because claim 11 is allowable, all of dependent claims 12-19 are allowable as well.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that there is no actual issue for appeal. The application can be allowed on the existing claims, and prosecution can remain closed.

Respectfully submitted,

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May 3, 2007